

## **REMARKS**

### **Summary of the Office Action**

The drawings has been objected to for failing to illustrate a coating.

Claims 1, 4-6, 21-22, and 24-25 have been rejected under 35 U.S.C. 102(b) as allegedly anticipated by U.S. Patent No. 4,960,410 to Pinchuk ("Pinchuk").

Claims 13, 23, and 26 have been rejected under 35 U.S.C. 103(a) as allegedly obvious over Pinchuk in view of U.S. Patent No. 5,951,494 to Wang ("Wang").

Claims 7-8 have been held to contain allowable subject matter but have been objected to because depending from a rejected base claim.

### **Response to the Office Action**

#### **A. In the Specification**

Paragraphs [0002] and [0008] have been amended to correct informalities. Paragraph [0031] has been amended to introduce reference numeral 19, which identifies the coating as requested by the Examiner. Paragraph [0036] has been amended to replace reference numeral 17 with 20, because reference numeral 17 has been employed to identify a different component in FIG. 5. No new matter has been added.

#### **B. In the Drawings**

Replacement drawing sheet 1/2 is enclosed herein. In FIG. 1, reference numeral 17 has been replaced with 20, because reference numeral 17 had already been employed to identify a different component in FIG. 5. In FIG. 4, reference numeral 19 has been introduced to identify the coating, as requested by the Examiner.

#### **C. In the Claims**

Claims 1, 4-8, 13 and 21-26 are pending in the application. Claims 1, 21, and 24 are amended herein. Therefore, upon entry of the present amendment, claims 1, 4-8, 13 and 21-26 will be subject to examination.

**1. The Rejection under 35 USC 102(b)**

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. 102(b), each and every element of Applicants' claims must be found, "either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as contained in the claims. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also* MPEP § 2132.

Applicants submit that independent claim 1 is not anticipated by Pinchuk because Pinchuk does not teach or suggest that the "guiding wire lumen comprises a pipe having coupled proximal and distal portions ... wherein the proximal and distal portions are each made of a solid material, the material of the proximal portion being more rigid than the material of the distal portion."

Pinchuk discloses a catheter having a two-part tubular member that defines a passageway extending completely through the catheter. The proximal portion of the tubular member is a relatively stiff tube that is narrowed in the distal portion by grinding or necking the outer surface of the tube, or by stretching the distal portion of the tube. A spiral through-cut is carved in the distal portion to increase flexibility, with a flexible sheath covering the grooved distal portion to insure that the tubular member can hold pressure.

Therefore, Pinchuk does not teach or suggest that the catheter shaft has "coupled proximal and distal portions," but instead that the catheter is made of a single piece. Further, Pinchuk does not teach or suggest that "the proximal and distal portions are each made of a solid material," because the distal portion of Pinchuk is not solid but has one or more through-grooves carved therein. Still further, Pinchuk does not teach or suggest that "the material of the proximal portion is more rigid than the material of the distal portion," because Pinchuk discloses only that the proximal and distal portion are made of the same material, and that the distal portion is covered with a sleeve that may be made with a softer material.

In discussing Pinchuk, the Examiner has stated out that "another broad interpretation [of different flexibility] could be wall thickness," which Applicants interpret as meaning that Pinchuk does not necessarily require a groove cut through the distal portion of the catheter. Applicants submit that this is not correct. While wall thickness is a factor considered by Pinchuk

for increasing wall flexibility, Pinchuk always requires the presence of a groove cut through the distal portion. See, for example, col. 1, ll. 63-68, particularly the use of the term “and in addition,” and also the embodiments described by Pinchuk.

Independent claim 21 is not anticipated by Pinchuk because Pinchuk does not teach or suggest a “catheter shaft comprising a pipe having proximal and distal portions and a solid cross-section, separate first and second boreholes extending longitudinally within at least a portion of the catheter shaft,” because this type of construction is not even discussed in Pinchuk.

Independent claim 24 is also not anticipated by Pinchuk because Pinchuk does not teach or suggest “a catheter shaft ... wherein separate first and second boreholes extend longitudinally within at least a portion of the proximal or distal ends, and wherein the first borehole defines a guiding wire lumen and the second borehole defines an inflation lumen for connecting the connecting piece to the inflatable balloon,” because this type of construction is also not discussed in Pinchuk.

Therefore, independent claims 1, 21 and 24 are not anticipated by Pinchuk, and the withdrawal of the rejection under 35 USC 102(b) is respectfully requested. The dependent claims are also not anticipated by Pinchuk at least for the same reasons as independent claims 1, 21 and 24.

## **2. The Rejection under 35 USC 103(a)**

Applicants submit that claims 13, 23, and 26 are patentable under 35 U.S.C. 103(a) over Pinchuk in view of Wang for at least the reasons described below.

A prima facie case of obviousness requires: (1) a suggestion or reason to combine; (2) a reasonable expectation of success; and (3) a teaching or suggestion of all claim limitations in the prior art. *Brown & Williamson Tobacco Corp. v. Philip Morris*, 229 F.3d 1333, 1342 (Fed. Cir. 2003); *In re Regal*, 526 F.2d 1399, 1403 (C.C.P.A. 1975).

Pinchuk has been discussed above. The Examiner cited Wang for adding to Pinchuk the missing element of a surface coating. As shown previously, Pinchuk does not disclose Applicants' invention regardless the coating element. Therefore, the combination of Pinchuk and Wang also does not teach Applicants' invention, and the withdrawal of the rejection under 35 U.S.C. 103(a) is respectfully requested.

**Conclusion**

In view of the foregoing amendment and comments, applicant respectfully submits that claims 1, 4-8, 13, and 21-26 are now in condition for allowance. Reexamination and reconsideration of the pending claims are respectfully requested.

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Respectfully submitted,

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